



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,281	07/31/2003	David R. Schaer	22330-RA	3768
30184	7590	12/10/2003	EXAMINER	
MYERS & KAPLAN, INTELLECTUAL PROPERTY LAW, L.L.C. 1899 POWERS FERRY ROAD SUITE 310 ATLANTA, GA 30339			CEGIELNIK, URSZULA M	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/631,281	SCHAER, DAVID R.
	Examiner	Art Unit
	Urszula M Cegielnik	3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,8-14,16-19 and 22-27 is/are rejected.
- 7) Claim(s) 6,7,15,20 and 21 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 8, 9, 11, 12, 16, 18, 19, 22, 23, 25, 26, and 27 are rejected

under 35 U.S.C. 102(e) as being anticipated by Holenstein et al.

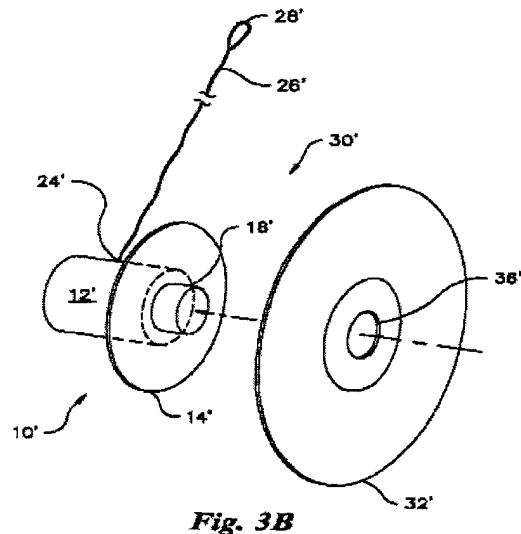


Fig. 3B

Holenstein et al. disclose a spinning top comprising a compact disc (32') and a spinning head (10') comprising means (18') for engaging a compact disc (32') at an axially concentric position as recited in claim 1; the compact disc selection includes promotional CDs (col. 1, lines 16-21) as recited in claim 2; the means for engaging the

compact disc (32') at an axially concentric position is a hub (18') as recited in claim 4; the means (18') for engaging the compact disc (32') at an axially concentric position is a hub, wherein the hub (18') is dimensioned, and downwardly tapered to a larger diameter (the bottom portion of reference numeral 18'), to facilitate frictional engagement of the hub (18') with a central aperture (36') of the compact disc (32') as claimed in claim 5; the means for engaging the compact disc at an axially concentric position is an adhesive that is glue (col. 3, lines 18-21) as recited in claim 8; the means for engaging the compact disc at an axially concentric position includes o-rings (col. 4, lines 28-30) as recited in claim 9; a spinning top comprising a compact disc (32') comprising a central aperture (36'); and a spinning head (10') comprising a hub (18') dimensioned, and downwardly tapered to a larger diameter, to facilitate frictional engagement of the central aperture (36') of the compact disc (32') therewith as recited in claim 11; the compact disc selection includes promotional CDs (col. 1, lines 16-21) as recited in claim 12; a method of converting a compact disc into a spinning top, the method comprising the steps of obtaining a spinning head (10') comprising means (18') for engaging a compact disc (32') at an axially concentric position; engaging the compact disc (32') with the means (18') for engaging; and spinning the spinning head (10') with the compact disc (10') engaged therewith as recited in claim 16; the means for engaging the compact disc (32') at an axially concentric position is a hub (18') as recited in claim 18; the means (18') for engaging the compact disc (32') at an axially concentric position is a hub, wherein the hub (18') is dimensioned, and downwardly tapered to a larger diameter (the bottom portion of reference numeral 18'), to facilitate frictional

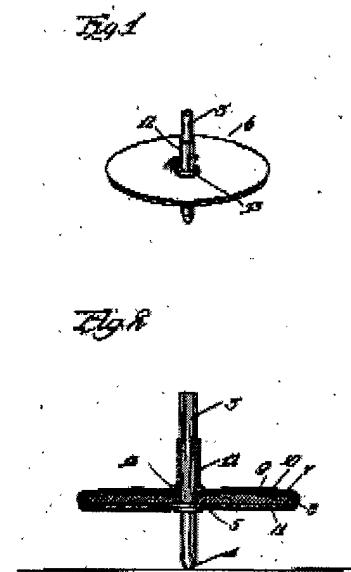
engagement of the hub (18') with a central aperture (36') of the compact disc (32') as claimed in claim 19; the means for engaging the compact disc at an axially concentric position is an adhesive that is glue (col. 3, lines 18-21) as recited in claim 22; the means for engaging the compact disc at an axially concentric position includes o-rings (col. 4, lines 28-30) as recited in claim 23; a spinning head (10') comprising a hub (18') dimensioned to frictionally engage a compact disc (32') at an axially concentric position as claimed in claim 25; a method of advertising, comprising the step of supplying a consumer with a spinning head (10') adapted to retain a compact disc (32') in an axially concentric position therewith (col. 4, lines 1-7), the compact disc comprising promotional material thereon (col. 1, lines 16-21 and col. 4, lines 40-45) as recited in claim 26, and the step of distributing the spinning head in combination with the compact disc (col. 4, lines 7-10) as recited in claim 27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 10, 13, 14, 16, 17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidenreich in view of Holenstein et al.



Heidenreich disclose a spinning top comprising a disc (6) and a spinning head (12) comprising means (13) for engaging a disc (6) at an axially concentric position as recited in claim 1; the spinning head (12) comprises a shallow conical-shaped base (4) as recited in claim 3; the spinning head (12) comprises a shaft (3) for spinning said spinning head (12) as claimed in claim 10; the spinning head (12) comprises a shallow conical-shaped base (4) as claimed in claim 13; said spinning head (12) comprises a shaft (3) for spinning said spinning head (12) as claimed in claim 14; the method steps comprising obtaining a spinning head (12) comprising means (13) for engaging a disc (6) at an axially concentric position; engaging the disc (6) with said means (13) for engaging; and, spinning said spinning head (12) with the disc (6) engaged therewith as recited in claim 16; a said the spinning head (12) comprises a shallow conical-shaped base (4) as recited in claim 17; the spinning head (12) comprises a shallow conical-

shaped base (4) as recited in claim 17; the spinning head (12) comprises a shaft (3) for spinning said spinning head (12) as claimed in claim 24.

Heidenreich does not disclose the disc being a compact disc as claimed in claim 1.

Holenstein et al. teaches a spinning toy having a disc in the form of a compact disc.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the disc of Heidenreich with a compact disc as taught by Holenstein et al., since Holenstein et al. states at col. 1, lines 19-21 that such a modification would allow compact discs received in the mail or with purchased products to be made useful.

Allowable Subject Matter

Claims 6, 7, 15, 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

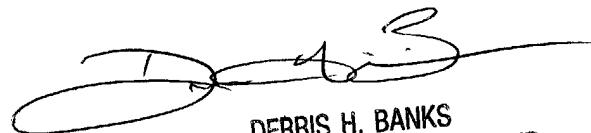
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 703-306-5806. The examiner can normally be reached on Monday through Friday, from 6:45AM - 3:15PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 703-308-1745. **The fax phone number**

for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at 703-306-5648.

Urszula M. Cegielnik
Assistant Examiner
Art Unit 3712



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700